

REMARKS

I. STATUS OF CLAIMS

Claims 96, 142, 167, 170, 175, 203, and 206 are pending in this application. No claim is amended herein.

II. REJECTION UNDER 35 U.S.C. § 112, FIRST PARAGRAPH

Claims 96, 142, 167, 170, 175, 203, and 206 are rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. Office Action at 2-8. Specifically, the Examiner asserts that “[t]here is no support in the specification for species belonging to structuring polymer, which is **‘ethylenediamine/stearyl dimer tallate copolymer’**.” *Id.* at 2.

Applicants respectfully disagree with the Examiner’s assertion; Applicants maintain that one of ordinary skill would have known that ethylenediamine/stearyl dimer tallate copolymer was known by the trade name Uniclear®, as set forth in the specification, at the time the application was filed.

According to the International Cosmetic Ingredient Dictionary and Handbook, page 606, 9th ed. (2002), submitted with the Reply to Office Communication filed May 22, 2008, ethylenediamine/stearyl dimer tallate copolymer, which has the tradename Uniclear, is a copolymer of ethylenediamine and tall oil dimer acid monomers end blocked with stearyl alcohol. Applicants submit that written description for this copolymer can be found in the original specification at paragraph [0061] bridging pages 16-17, which states that:

Non-limiting examples of at least one polyamide polymer may be used in the composition according to the present invention include commercial products sold by Arizona

Chemical under the names Uniclear 80 and Uniclear 100. These are sold, respectively, in the form of an 80% (in terms of active material) gel in a mineral oil and a 100% (in terms of active material) gel. These polymers have a softening point from 88 to 94°C, and may be mixtures of copolymers derived from monomers of (i) C₃₆ diacids and (ii) ethylene diamine, and have a weight-average molecular mass of about 6000. Terminal ester groups result from the esterification of the remaining acid end groups and at least one alcohol chosen from cetyl alcohol and stearyl alcohol. A mixture of cetyl and stearyl alcohols is sometimes called cetylstearyl alcohol.

(emphasis added).

As the Examiner points out on page 3 of the Office Action, the above description in the specification teaches species that can be formed from:

(i) C36 diacids and ethylenediamine and the terminal ester groups result from esterification of the remaining acid end groups can be with cetyl alcohol or the species can be formed from (ii) C36 diacids and ethylene diamine and the terminal ester groups result from esterification of the remaining acid **end groups can be with stearyl alcohol or** the species can be formed from [(iii)] C36 diacids and ethylenediamine and the terminal ester groups result from esterification of the remaining acid end groups can be with a mixture of cetyl and **stearyl alcohols** also known as cetylstearyl alcohol.

(emphasis added). This description readily conveys a copolymer of ethylenediamine and tall oil dimer acid monomers end blocked with stearyl alcohol such as the ethylenediamine/stearyl dimer tallate copolymer recited in independent claims 96 and 203.

In addition, Applicants submit herewith as Exhibit 1, a redacted copy of an Expert Report of Robert Lochhead, Ph.D., submitted on December 15, 2006, in *L'Oréal S.A. v. Estée Lauder Co.*, Civil Action No. 04-1660 (HAA) (D.N.J. filed Apr. 7, 2004), and as

Exhibit 2, a letter from the Cosmetic Toiletry and Fragrance Association ("CFTA") dated December 14, 1999, and relied upon in the Expert Report. At paragraph 14 of his report, Dr. Lochhead states that persons skilled in the art reading the disclosure regarding Uniclear® in the specification of the patent at issue (which corresponds to the present specification) would have understood that the inventors contemplated use of ethylenediamine/stearyl dimer tallate copolymer as a structuring polymer. Applicants submit that the teachings provided in the information already of record, as well as the teachings provided by the additional evidence submitted herewith, establish that the ethylenediamine/stearyl dimer tallate copolymer was known by those of ordinary skill as Uniclear® at the time of filing of the present application, October 5, 2001 (based on the parent application, U.S. Application No. 09/971,028).

Moreover, a trademarked product may cover a range of products containing the same copolymer family, but having different concentrations, in different solvents or with different additives, leading to different physicochemical properties. As mentioned in the specification, Uniclear 80 and Uniclear 100 have different formulations. For example, Uniclear 80 and Uniclear 100 contain different concentrations of active material. Such difference in concentrations may explain the different softening points discussed by the Examiner at page 7 of the Office Action.

In summary, the specification describes the copolymers known as Uniclear® and demonstrates that Uniclear® is the trade name for ethylenediamine/stearyl dimer tallate copolymer. Moreover, the CFTA's December 14, 1999, letter and Dr. Lochhead's Expert Report, which relies upon the CFTA's letter, which is submitted herewith, is further evidence that the ethylenediamine/stearyl dimer tallate copolymer was known by

those of ordinary skill as Uniclear® at the time of filing of the present application, October 5, 2001. Accordingly, Applicants submit that independent claims 96 and 203, and the claims that depend therefrom, are fully supported by the specification as filed.

In view of the foregoing, Applicants respectfully request that the Examiner reconsider and withdraw the rejection.

III. REJECTION UNDER 35 U.S.C. § 103

Claims 96, 142, 167, 170, 203, and 206 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over the combination of U.S. Patent No. 5,783,657 to Pavlin et al. ("Pavlin") and WO Patent Application Publication No. 2001/17488 to Collin et al. ("Collin"). Office Action at 8. In addition, claim 175 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over the combination of Pavlin and Collin, and further in view of U.S. Patent No. 6,423,324 to Murphy et al. ("Murphy"). *Id.* at 11.

Each of claims 96, 142, 167, 170, 175, 203, and 206 comprise, *inter alia*, "at least one heteropolymer chosen from ethylenediamine/stearyl dimer tallate copolymer and ethylenediamine/stearyl dimer dilinoleate copolymer." Pavlin, on the other hand, only teaches a composition comprising a polyamide of formula (I), encompassing thousands, if not millions, of possible structuring polymers to try.

"The fact that a claimed species or subgenus is encompassed by a prior art genus is not sufficient by itself to establish a *prima facie* case of obviousness." M.P.E.P. §2144.08 (citing *In re Baird*, 16 F.3d 380, 382, 29 USPQ2d 1550, 1552 (Fed. Cir. 1994) ("The fact that a claimed compound may be encompassed by a disclosed generic formula does not render the compound obvious.")). While Pavlin discloses an ester-terminated polyamide (ETPA) of formula (I), there is no disclosure of the claimed

species of structuring polymers, e.g., Uniclear, recited in claims 96, 142, 167, 170, 175, 203, and 206. Moreover, there is no teaching or suggestion in Pavlin that would direct one of ordinary skill in the art to choose Uniclear rather than one of the other structuring polymers encompassed by formula (I). In fact, Pavlin would direct one of ordinary skill in the art away from Uniclear.

Uniclear is derived from the condensation polymerization of: about 76.62 wt% of a dimer acid (Empol 1011), about 5.87 wt% of an amine (ethylene diamine), and about 17.51 wt% of an alcohol (Alfol-18, i.e., stearyl alcohol).¹ See Information Relevant to the Use and Availability of UNICLEAR 80/100, attached herewith as Exhibit 3. From a review of Pavlin, the closest ester-terminated polyamide (ETPA) to Uniclear is Example 8. See Pavlin, col. 20, line 55 to col. 21, line 14. Example 8 is an ETPA derived from 76.4 wt% of the dimer acid Empol 1008, 5.9 wt% of ethylene diamine, and 19.7 wt% of stearyl alcohol. See *id.* Example 8, however, reports that gels formed from this Uniclear-like structurant made from 19.7 wt% stearyl alcohol were opaque, not clear. See *id.* at col. 21, lines 12-14. Further, Example 8 warns that “[t]his example shows that there is a lower limit to the alcohol concentration that can be used in an ETPA, and still obtain a transparent gel therefrom.” See *id.* at col. 20, lines 60-62. In view of the fact that Uniclear is an ETPA that is derived from only about 17.51 wt% stearyl alcohol, it is below the lower limit taught by Pavlin for making clear gels. Accordingly, a person of ordinary skill in the art would have been directed away from using Uniclear as the structuring polymer by this disclosure in Pavlin.

¹ Alfol-18 is a tradename for stearyl alcohol. See International Cosmetic Ingredient Dictionary and Handbook 1654 (9th ed. 2002), submitted herewith as Exhibit 4.

A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. See M.P.E.P. § 2141.02(VI). Indeed, the totality of the prior art must be considered, and proceeding contrary to accepted wisdom in the art is "strong evidence of unobviousness." *In re Hedges*, 783 F.2d 1038, 1041, 228 U.S.P.Q. 685, 687 (Fed. Cir. 1986). When the disclosure of Pavlin is considered in its entirety, as required, see M.P.E.P. § 2141.02(VI), a person would have been directed away from Uniclear by Pavlin teaching that a stearyl alcohol concentration of 19.7 wt% or below in an ETPA would form an undesirable opaque gel. This teaching away in Pavlin would have led one of ordinary skill in the art to other disclosed ETPA structuring polymers with a stearyl alcohol concentration of greater than 19.7 wt%. Thus, common sense would dictate against both selection and addition of Uniclear from among the other ETPA structuring polymer disclosed in Pavlin.

Collin and Murphy do not rectify the deficiencies of Pavlin discussed above. Thus, Applicants submit that the Examiner failed to establish a *prima facie* case of obviousness over Pavlin and Collin, alone, or in combination with, Murphy. Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw each of the foregoing rejections.

IV. OBVIOUSNESS-TYPE DOUBLE PATENTING REJECTIONS

The Examiner disapproves of the Terminal Disclaimer filed on May 20, 2009. Thus, the Examiner maintains the obviousness-type double patenting rejections of claims 96, 142, 167, 170, 203, and 206 over U.S. Patent Nos. 6,716,420, 7,008,619, 6,402,408, 6,835,399, 6,869,594, 6,881,400, 6,960,339, 6,979,469, 7,008,629, 7,011,823, 7,144,582, 6,432,391, 7,025,953, 7,052,681, and 7,023,552. *Id.* at 12.

According to the Examiner, the Terminal Disclaimer is disapproved because U.S. Patent No. 7,023,552 is assigned to "L'Oréal" rather than "L'Oréal S.A." *Id.*

Applicants submit herewith as Exhibit 5, a copy of an Assignment, filed with the United States Patent And Trademark Office on November 18, 2009, which assigns the entire right, title, and interest in U.S. Application No. 10/203,374, which issued as U.S. Patent No. 7,023,552 on April 4, 2006, to L'Oréal S.A. Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw her disapproval of the Terminal Disclaimer filed on May 20, 2009.

The Examiner also rejects the pending claims under the judicially-created doctrine of obviousness-type double patenting on five new grounds:

Claims 96 and 203 are rejected on the ground of non-statutory obviousness-type double patenting as allegedly being unpatentable over claims 1 and 2 of U.S. Patent No. 7,008,619;

Claims 96, 142, 167, 170, 203, and 206 are rejected on the ground of non-statutory obviousness-type double patenting as allegedly being unpatentable over claims 1 and 13 of U.S. Patent No. 7,276,547 in view of Collin and Murphy;

Claims 96, 142, 167, 170, 203, and 206 are rejected on the ground of non-statutory obviousness-type double patenting as allegedly being unpatentable over claims 18, 20, and 21 of U.S. Patent No. 7,314,612 in view of Collin and Murphy;

Claims 96, 142, 167, 170, 203, and 206 are rejected on the ground of non-statutory obviousness-type double patenting as allegedly being unpatentable over claims 1, 5, and 18 of U.S. Patent No. 7,351,418 in view of Collin and Murphy; and

Claims 96, 142, 167, 170, 203, and 206 are rejected on the ground of non-statutory obviousness-type double patenting as allegedly being unpatentable over claims 1, 29, and 30 of U.S. Patent No. 7,410,636 in view of Collin and Murphy.

Id. at 12-19.

While Applicants respectfully submit that the present invention is not obvious over any claims in the patents cited by the Examiner, to expedite allowance of the present application, Applicants submit herewith a Terminal Disclaimer to obviate each of the obviousness-type double patenting rejections listed above. Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw all of the obviousness-type double patenting rejections.

V. COMMONLY ASSIGNED CO-PENDING APPLICATIONS AND PATENTS

In previous submissions, Applicants noted information regarding co-pending applications and patents, including the present application, and submitted copies of the pending claims as of the date of those submissions for every case identified. Applicants submit herewith, as Exhibit 6, a copy of the pending and/or issued claims of Application Nos. 10/747,412, 09/733,899, 09/733,900, 09/749,036, 09/733,897, and 10/746,612, which have been amended or issued since May 20, 2009. Applicants submit those claims for the Office's convenience in evaluating any potential issues regarding statutory or obviousness-type double patenting.

VI. CONCLUSION

In view of the foregoing remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

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GARRETT & DUNNER, L.L.P.

Dated: November 18, 2009

By: Jennifer R. Gupta
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Attachments:

- Exhibit 1 -** Expert Report of Robert Lochhead, Ph.D., submitted on December 15, 2006, in L'Oréal S.A. v. Estée Lauder Co., Civil Action No. 04-1660 (HAA) (D.N.J. filed Apr. 7, 2004);
- Exhibit 2 -** Letter from the Cosmetic Toiletry and Fragrance Association ("CTFA") dated December 14, 1999;
- Exhibit 3 -** Information Relevant to the Use and Availability of UNICLEAR 80/100;
- Exhibit 4 -** International Cosmetic Ingredient Dictionary and Handbook ("CTFA") 9th ed., p. 1654 (2002);
- Exhibit 5 -** Copy of Assignment filed with the USPTO on November 18, 2009, which assigns U.S. Application No. 10/203,374, which issued as U.S. Patent No. 7,023,552, to L'Oréal S.A.; and
- Exhibit 6 -** Six (6) Sets of Claims from Co-Pending Applications